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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,563	04/12/2000	Mark D. Siegler	68410	6313

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EXAMINER

COHEN, CURTIS A

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 01/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/547,563

Applicant(s)
Siegler et al

Examiner
Curtis Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 16, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Reissue Applications

Claims 5-16 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The Declaration of the instant application states that it is applicants' intent to broaden the scope of the claims. Specifically, the parent applications (U.S. Serial Numbers 08/829,742, now Patent Number 5,743,046, which is a continuation of Serial Number 08/456,874, abandoned) include claims having the structure of a "means for preventing the garage door from opening." The instant application includes two new independent claims having language that replaces the "means for preventing" with *a portion* of all the elements recited in the specification that are encompassed by the "means for preventing." Broadening the scope of the claims constitutes impermissible recapture for the following reasons.

In the parent applications, claims 1-4 were rejected under Section 102(b) as being anticipated by Ball et al. Arguments were presented in the amendment filed as paper number 7 of Serial Number 08/456,874 that persuaded the examiner that the claims were allowable over the prior art of record (see arguments on page 4-5 of the amendment). In those arguments,

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structural details of the elements that constitute the means for preventing the garage door from opening are set forth. Particularly, on page 5 of the amendment, applicants purport that Ball et al *fails to disclose a means for preventing the garage door from opening* (page 5, lines 3-5) where the structure defining the means was set forth on the previous page of the arguments.

A means plus function clause under Section 112 (6th paragraph) encompasses the structure and function as recited in the specification, along with any equivalence thereof. Since applicant is now reciting the particular structure and function, *which does not include any equivalent structure*, the claim would appear to be narrowed, not broadened. However, this only applies if every single element recited in the specification that is encompassed by the “means for preventing” is included in the independent claims. This is not the case. The independent claims fail to recite every element set forth in the specification that makes up the “means for preventing rotation.”

Allowable Subject Matter

Claims 1-4 are allowed.

Response to Arguments

Applicants argue in the second paragraph on page 2 of the amendment that the examiner has erred in concluding that the applicants have effectively canceled a claim to any particular subject matter within the meaning of *Ball*. Applicants emphasize that the only amendment to the claims of the parent was inserting the word “and” to correct grammatical errors. From the outset, the form paragraph used in the previous Office Action was inaccurate and since has been

- ① fails to recite All elements disclosed in spec that constitutes the means
- ② Even if specific hinges were included it still fails to meet the equiv. structure

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amended by the Office to state the claimed subject matter is “surrendered”, not “canceled.”

Regarding applicant’s allegation that the claims of the parent application contain no canceled subject matter within the meaning of *Ball*, it is not a requirement that the subject matter be canceled to constitute a proper recapture. Rather, the language of the claims must merely be *surrendered*. A persuasive argument, without an amendment to the claims, is sufficient to establish recapture. In this case, the means for preventing is surrendered by the arguments provided in the parent application that persuaded the examiner to allow the claim (*In re Clement*, 131 F.3d. 1464, 45 USPQ2d 1161 (Fed. Cir, 1997)).

Applicants argue in paragraphs 3 and 4 that merely pointing out the differences between the teachings of the prior art and the specific claim language of “a drive unit” and “a means for preventing the garage door from opening” does not trigger the recapture rule. Applicants imply that the precedence set in *Hester Industries Inc. V. Stein Inc.*, 46 USPQ2d 1641 (C.A.F.C. 1998), requires the argument to be set forth more than a single instance. The claims of the parent application were allowed based upon applicants’ arguments that the prior art fails to teach or disclose the means for preventing the garage door from opening. As previously stated, the arguments in the parent application on page 4, continuing to page 5, clearly indicate applicants’ assertion that there is no teaching or suggestion in *Ball et al* (the reference applied in the Section 102(b) in the parent case) of the elements *disclosed in the specification which constitute the means for preventing the garage door from opening*. This argument persuaded the examiner to withdraw the rejection and allow the claims. When deciding whether or not a claim is

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patentable, every argument is considered equally. Arguments are not weighted according to the number of occurrences in the Remarks. Therefore, the persuasive argument filed in the parent application need only be stated once to place the claims in condition for allowance.

Applicants argue in paragraphs 6 and 7 of page 2 that the parent application purported that "Ball et al fails to disclose *at least two* elements of claim 1." Applicants allege that rejection based on Ball et al failed to teach *more than one of feature*, (i.e., the means for preventing the garage door from opening and the drive unit) to distinguished the independent claim in the parent case from Ball et al. The combination of features may have been presented in the arguments of the parent case, however, this does not mean that the claims were allowed for *both* reasons. In fact, garage door "drive units" are well known to those of ordinary skill in the art as well as any owner of a motorized garage door opening device. The examiner relied solely on the "means for preventing" language as the distinguishing feature of the claim and not the combination of elements. Further, it is the "means for preventing", not the "drive unit", that is the language of importance because the "means for preventing" is the element that is narrowed by the independent claims in the reissue.

Finally, applicants argue that the examiner disregarded the fact that both of the two new independent claims are broader in scope than the parent application's claims because certain language has been deleted from the claims (see the bottom of page 2 of the arguments). If this language were the only changes made to claims, the claims would in fact be broader. However,

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if one element of the independent claims is narrowed, then the entire claim is considered narrowed regardless if other elements were deleted from the claim.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

The fax phone number for this Group is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

C. Cohen

January 10, 2002



DANIEL P. STODOLA
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